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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/213,169 12/17/98 FREDLUND

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EXAMINER
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PHAN, D	
ART UNIT	PAPER NUMBER

3722  
DATE MAILED:

04/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/213,169

Applicant(s)

John R. Fredlund

Examiner

Daniel Phan

Group Art Unit  
3722



☒ Responsive to communication(s) filed on Feb 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-36 and 40-63 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-36 and 40-63 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **Faxing of Responses to Office Action**

In order to reduce pendency and avoid potential delay, TC 3700 is encouraging FAXING of responses to office action directly into the Group at (703)305-3579. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Drawings***

1. New formal drawings are required in this application because the drawing applicant submitted for examination is not formal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

### ***Claim Objections***

2. Claim 35 is objected to because of the following informalities: "the a first source" typo error, it is suggested that applicant delete the word "the". Appropriate correction is required.

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***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, line 7, "said album leaf," lacks proper antecedent basis.

In claim 13, lines 8-9, "the original source," lacks proper antecedent basis.

In claim 25, line 5, "said at least," lacks proper antecedent basis.

In claim 25, line 7, "said album leaves," lacks proper antecedent basis.

In claim 25, line 9, "the original source," lacks proper antecedent basis.

In claim 29, line 4, "and/or" renders the claim indefinite because it is unclear if applicant is claiming the elements in combination or in the alternative, thus rendering the scope of the claim unclear.

In claim 52, line 7, "said album leaves," lacks proper antecedent basis.

In claim 52, lines 8-9, "the original source," lacks proper antecedent basis.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 7, 12, 13, 19, 23-25, 29, 34, 35, 40, 43, 44, 46, 50-52, 57, 58, 62 and 63, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (U.S. Patent 5,791,692) in view of Shiota (4,903,068).

Manico et al discloses a album leaf comprising a plurality of images (15-19 and 21-25), first and second sides (12, 14) having a retaining means for holding the memory images, and a plurality of openings (28) (see Figure 1-2) for allowing the album photographic paper leaves (see column 2, lines 9-11) to be placed into a binder.

Manico does not disclose first and second icons for identifying first and second sources of the memory images on the photographic sheets. Shiota discloses a photographic sheet comprising an icon (64) (see column 4, lines 22-31) with an image ID (65) (see Fig. 2) inside of the silhouette (60a, 61a) (see Fig. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an icon with identification number which corresponds to the images on the album leaf as taught by Shiota to arrange the content and to provide more information on the images.

Further, Shiota does not disclose the second icon. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide another icon on the photographic sheets, since it has been held that mere duplication of the essential working

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parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

7. Claims 2, 14, 26, 41 and 53, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (U.S. Patent 5,791,692) in view of Shiota (U.S. Patent 4,903,068) and further in view of Manico et al (U.S. Patent 5,764,870).

Monico et al (U.S. 5,791,692) as modified by Shiota (U.S. Patent 4,903,692) discloses the invention as set forth in the above except for an origination ID being associated with at least one of the plurality of images which indicates the first source.

Monico et al (U.S. Patent 5,764,870) discloses a photographic sheet comprising an origination ID (see Fig. 9a-9c). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an origination ID (see Fig. 9a-9c) inside the silhouette (60a, 61a) (see Fig. 2) as taught by Monico et al (U.S. Patent 5,764,870) to indicate the identification images and the location of the images on the photographic sheet.

With respect to claims 3, 15, 16, 27, 36, 42, 54, and 55, Monico et al (U.S. 5,791,692) as modified by Shiota (U.S. Patent 4,903,692) discloses the invention as set forth above except for a photographic sheet margin area separated from the images wherein the icon is located.

Monico et al (U.S. Patent 5,764,870) discloses a photographic sheet comprising a margin on the photographic sheet (see Fig. 9a-9c) and a retaining mean having a plurality of pockets to retain the memory images (30 and see Fig. 3).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a margin area on the sheet as taught by Monico et al (U.S. Patent 5,764,870) to contain the photographic sheet information such as an image ID and a cartridge ID associated with a plurality of images.

With respect to claims 4, 5, 17, 28, 43, 44 and 56 Monico et al (U.S. 5,791,692) as modified by Shiota (U.S. Patent 4,903,692) and further modified by Monico et al (U.S. Patent 5,764,870) inherently teaches that the albums leaves having three openings for allowing the album leaves to be placed into a three ring binder (see Fig. 9a-9c).

With respect to claims 6, 18, 30 and 45, Monico et al (U.S. 5,791,692) as modified by Shiota (U.S. Patent 4,903,692) further modified by Monico et al (U.S. Patent 5,764,870) discloses the invention as set forth above except for a second icon provided on the first side for identifying a second source of a second image of the plurality of images originated on the first side, the second source being different from the first source.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the second icon on the first side for identifying a second source of the second image, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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8. Claims 8, 20, 31, 37 and 59, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (U.S. Patent 5,791,692) in view of Shiota (U.S. Patent 4,903,068) and further in view of Werner et al (U.S. Patent 5,709,496).

Manico et al (U.S. Patent 5,791,692) as modified by Shiota (U.S. Patent 4,903,068) discloses the invention as set forth above except for the source comprising a film cartridge containing a strip of photographic film wherein the cartridge has an ID number.

Werner et al (U.S. Patent 5,709,496) discloses an apparatus for storing a film cartridge (23) (see Fig. 1-5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a film cartridge on a photographic sheet as taught by Werner et al (U.S. Patent 5,709,496) so that the film cartridge can be kept together with corresponding images for later use, such as redeveloping.

Further, Werner et al does not disclose a cartridge comprising an identification number. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an ID on the film cartridge, since the examiner takes Official Notice that film cartridges provided an ID number is well known within the level of ordinary skill in the art.

9. Claims 9, 10, 21, 22, 32, 33, 48, 49, 60 and 61, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (U.S. Patent 5,791,692) in view of Shiota (U.S. Patent 4,903,068) further in view of Combs (U.S. Patent 5,782,349).



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Manico et al (U.S. Patent 5,791,692) as modified by Shiota (U.S. Patent 4,903,068) discloses the invention as set forth above except for the source comprising a CD having an ID thereon.

Combs (U.S. Patent 5,782,349) discloses a CD ROM holder comprising a CD ROM (10) (see Fig. 2) on the photographic sheet.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a CD ROM on a photographic sheet as taught by Combs (U.S. Patent 5,782,349) so that the sheet can be used to contain not only picture images and films but it can be used for a CD ROM holder as well.

Further, Combs does not disclose a CD ROM comprising an identification number. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an identification number on the CD ROM, since the examiner takes Official Notice that CD ROMS with an identification number are well known within the level of ordinary skill in the art.

### ***Response to Arguments***

10. Applicant's arguments filed 2/4/00 have been fully considered but they are not persuasive.

Applicant argues that Ruebens does not teach for providing first and second icons as taught and claimed by applicant. However, Shiota (U.S. Patent 4,903,068) discloses a photographic paper comprising an icon (64 and see column 4, lines 22-31), wherein the icon

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having a silhouette (60a, 61a) (see Fig. 2) to contain information of corresponding images on the photographic sheet.

Applicant also argues that Rowley does not teach the photographic sheet having an image ID and an origination ID that are enclosed in the icons. Shiota discloses a photographic paper comprising an icon with an image ID (65) (see Fig. 2) inside of the silhouette. Shiota does not disclose an origination ID. However, Monico et al (U.S. Patent 5,764,870) discloses a photographic sheet comprising an origination ID (see Fig. 9a-9c) associated with the corresponding images.

Further, applicant argues that Werner and Combs do not disclose the claimed invention as the applicant claimed wherein applicant's invention is directed to a integral album leaf in which the images and indicia are integrally formed as a part of the leaf instead of forming an inserted pocket. However, applicant only claimed a photographic sheet with the sources comprising a CD having an ID without specifically claiming how the CD can be attached to the photographic sheets. Therefore, such limitations as argued by applicant were not given any weight.

### ***Contact Information***

11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Daniel Phan whose telephone number is (703) 308-4235. The examiner can normally be reached on Monday-Thursday from 7:30 a.m. to 6:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A.L. Pitts can be reached on (703) 308-2159. The fax number for TC 3700 is (703) 305-3579. Any inquiry of a general

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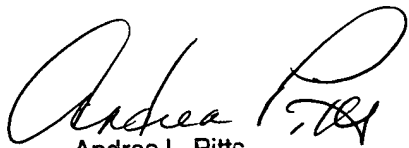
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nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703) 308-1148.

DP

March 17, 2000



Andrea L. Pitts  
Supervisory Patent Examiner  
Group 3700